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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,812	11/23/1999	KAZUROU OKUZAWA	00169/P17508	3098

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EXAMINER

KNABLE, GEOFFREY L

ART UNIT PAPER NUMBER

1733

DATE MAILED: 11/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/380,812

Applicant(s)

OKUZAWA ET AL.

Examiner

Geoffrey L. Knable

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10-4-2004 has been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Claim 1 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sato et al. (US 5,753,727).

Sato et al. is applied for the same reasons as set forth in the last office action. As to defining that the adhesive "consists essentially of" the noted components, although applicant has argued that this "consisting essentially of" language excludes large amounts of non-carboxylated chloroprene, it is not considered that such is clearly excluded as it has not been shown that such additional materials materially affect the basic and novel characteristics of the claimed invention (MPEP 2111.03). In fact, the basic and novel characteristics of the claimed adhesive would seem to be the ability to bond to polypropylene as well as heat durability (e.g. page 7, lines 8-9 of the specification). These however are exactly the same features as the Sato et al. adhesive (e.g. col. 2, lines 1-3) and thus it is entirely reasonable to consider that none of the other materials in Sato et al. would be excluded by this "consisting essentially of" language.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al. (US 5,753,727) as applied to claim 1 above, and further in view of the admitted state of the prior art as applied in the last office action.
5. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted state of the prior art taken in view of Smith (US 3,347,837) and/or the Kirk-Other Encyclopedia of Chemical technology excerpt (particularly sections 3.4 and 8.2) and optionally further in view of Sato et al. (US 5,753,727) and/or the abstract for JP 1-153781 (cited by applicant) as applied in the last office action.
6. Applicant's arguments filed 10-4-2004 have been fully considered but they are not persuasive.

Applicant has argued that the "consists essentially of" language excludes the presence of large amounts of uncarboxylated chloroprene rubber because such would "substantially effect the basic and novel properties of the claimed adhesive." However, as noted above, it is not considered that such is clearly excluded as it has not been shown that such additional materials materially affect the basic and novel characteristics of the claimed invention (MPEP 2111.03). In fact, the basic and novel characteristics of the claimed adhesive would seem to be the ability to bond to polypropylene as well as heat durability (e.g. page 7, lines 8-9 of the specification). These however are exactly the same features as the Sato et al. adhesive (e.g. col. 2, lines 1-3) and thus it is entirely reasonable to consider that none of the other materials in Sato et al. would be excluded by this "consisting essentially of" language.

Applicant also argues that the amendment to the claims "requires that carboxylated synthetic chloroprene be the main ingredient". These argument have been considered but are unpersuasive. First, the claims in fact make no reference to a "main ingredient." Further, it is clear that substantial amounts of other non-recited components are clearly not excluded (e.g. reinforcing resin - note table 3). Thus, in the final composition, the carboxylated chloroprene may not even make up the majority of the composition. The arguments in this regard are therefore not convincing.


As to the rejection using the admitted prior art as the primary reference, it is argued that Smith fails to suggest adhesion to polypropylene and the Kirk-Othmer encyclopedia excerpt fails to teach the claimed combination. These arguments have been considered but are unpersuasive. Again, as noted in the last office action, Smith is directed to carboxylated chloroprene rubber and in particular evidences an understanding that such polymers "may be used in many applications in place of conventional chloroprene polymers", they being "most useful for the preparation of solvent adhesives exhibiting good storage stability and capable of producing bonds having outstanding high temperature cohesive strengths" (col. 3, lines 56-62). It is considered that the artisan would have understood that this is suggesting/motivating general replacement of conventional chloroprene in many applications including especially adhesives, the admitted prior art providing clear evidence that such chloroprene rubber based adhesives are conventionally used in bonding polypropylene. The Kirk-Othmer Encyclopedia of Chemical technology excerpt relating to Polychloroprene (particularly sections 3.4 and 8.2) further similarly evidences an

understanding that "a minor amount of comonomer provides beneficial functional groups, e.g., carboxylated adhesives, where the comonomer promotes adhesion and cohesive strength" (section 3.4) and carboxylated chloroprene polymers such as neoprene AF provides "higher bond strength, especially hot bond strength" (section 8.2). In light of this apparent well known fact that carboxylated chloroprenes provide improved bond strength and particularly hot bond strength, it would have been prima facie obvious to utilize carboxylated forms of chloroprene in the otherwise conventional adhesive of the admitted prior art for the expected improvements in bonding. Applicant has not provided a convincing line of argument as to why the artisan would not expect these known improvements to follow for chloroprene based adhesives as in the admitted prior art.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Geoffrey L. Knable whose telephone number is 571-272-1220. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on 571-272-1156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Geoffrey L. Knable
Primary Examiner
Art Unit 1733

G. Knable
November 28, 2004